UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
PHAM, KHANH B

ART UNIT	PAPER NUMBER
2166	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/848,437	BLAIR ET AL.
	Examiner	Art Unit	
	Khanh B. Pham	2166	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>01 May 2009</u>.

2a) ☒ This action is **FINAL**.　　　　2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>21-92</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>21-92</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All　b) ☐ Some * c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   **Claims 21-92** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Unger et al. (US 5,721,910 A), in view of Hill et al. (US 5,787,424 A), hereinafter

referred to as "**Unger**" and "**Hill**".

        As per claim 21, Unger teaches a computer readable medium for performing a

method for enabling a user to organize and analyze information comprising:

- "searching a first group of document according to one or more search functions to
  output a second group of documents, wherein the second group of documents is a
  subset of the first group of documents" at Col. 3 lines 8-20

- "wherein the search functions comprises at least on of the following: morphological,
  lexical, syntactic, semantic, discourse, pragmatic, full text, Boolean, clustering
  function" at Col. 3 lines 8-20;

- "analyzing a third group of document according to one or more analytical functions to
  output a fourth group of documents, wherein the fourth group of documents is a
  subset of the third group of documents" at Col. 6 lines 25-55;

- "wherein the analytical functions comprises at least one of mapping functions, citation functions, plot lineage functions and reporting functions" at Col. 6 lines 25-55

    Unger does not explicitly teach "selectively iterating at least one of the searching step and analyzing step, wherein each iteration of the searching step or the analyzing step is performed using as input the second group of documents, the fourth group of documents, or the output of the previous iteration, wherein in said selectively iterating step includes: performing an additional iteration of the searching step using as input the second group of documents, to output a fifth group of documents, wherein the fifth group of documents is a subset of the second group of documents; and performing an additional iteration of the analyzing step using as input the fourth group of document to output a sixth group of documents, wherein the sixth group of documents is a subset of the fourth group of documents"

    Hill teaches a method for recursive document retrieval including the steps of selectively iterating at least one of the searching step and analyzing step, wherein each iteration of the searching step or the analyzing step is performed using as input the second group of documents, the fourth group of documents, or the output of the previous iteration, wherein in said selectively iterating step includes: performing an additional iteration of the searching step using as input the second group of documents, to output a fifth group of documents, wherein the fifth group of documents is a subset of the second group of documents; and performing an additional iteration of the analyzing step using as input the fourth group of document to output a sixth group of documents, wherein the sixth group of documents is a subset of the fourth group of documents" at

Col. 3 line 1 to Col. 4 line 25 and Figs. 1-4. Thus, it would have been obvious to one of

ordinary skill in the art at the time of the invention was made to combine Hill's iteration

method with Unger's method as suggested by Hill at Col. 4 lines 10-20, in order to

improve the relevancy of the search results, because: "this process solves a problem

with conventional document retrieval methods that if the repository of documents is

large, then conventional retrieval systems with reasonably high recall suffer from low

precision. These conventional system suffer from this problem because, to have high

recall, these system retrieve large number of documents, many of which are irrelevant",

as noted by Hill at Col. 4 lines 10-22.

As per claim 22, Unger and Hill teach the computer readable medium of claim

21 discussed above. Unger also teaches: "making at least one of the second group or

the fourth group a permanent group" at Col. 3 lines 45-50.

As per claim 23, Unger and Hill teach the computer readable medium of claim

21 discussed above. Unger also teaches: "wherein the searching comprises: performing

a cluster analysis of the first group of documents to create a hierarchical arrangement of

groups containing documents from the first group, wherein the second group is one of

the hierarchical arrangement of groups" at Col. 5 lines 35-63.

As per claim 24, Unger and Hill teach the computer readable medium of claim

21 discussed above. Unger also teaches: "performing a relevancy visualization analysis

of one of the first group and the third group to identify how documents contained therein

are inter-related with respect to key terms"

     As per claim 25, Unger and Hill teach the computer readable medium of claim

24 discussed above. Unger further teaches: "relevancy visualization analysis operates

according to a rule book" at Col. 5 lines 15-35.

     As per claim 26, Unger and Hill teach the computer readable medium of claim

25 discussed above. Unger further teaches : "wherein the rule book comprises patent

specific rule" at Col. 5 lines 15-35.

     As per claim 27, Unger and Hill teach the computer readable medium of claim

21 discussed above. Unger further teaches : "generating an object corresponding to a

search process component or an analyze process component of a work flow

represented by the searching, the analyzing, and selective iterating" at Col. 7 line 25 to

Col. 8 line 50.

     As per claim 28, Unger and Hill teach the computer readable medium of claim

27 discussed above. Unger further teaches: "wherein an object is generated using

object definition" at Col. 8 lines 35-50.

As per claim 29, Unger and Hill teach the computer readable medium of claim 28 discussed above. Unger further teaches: "wherein the object definition comprise: a Boolean operation object definition, a corporate family operating object definition; an export object definition; a folder object definition; an import object definition; a list exploder operation object definition; a list object definition; a query object definition; or a patent family dedupe object definition" at Col. 8 lines 35-50.

As per claim 30, Unger and Hill teach the computer readable medium of claim 27, Unger further teaches : "saving the at least one object" at Col. 7 lines 25-50.

As per claim 31, Unger and Hill teach the computer readable medium of claim 27, Unger further teaches: "re-executing the work flow by traversing the at least one object" at Col. 8 lines 50-62.

As per claim 32, Unger and Hill teach the computer readable medium of claim 27, Unger further teaches: "creating a new work flow by modifying the at least one object" at Col. 8 lines 50-62.

As per claim 33, Unger and Hill teach the computer readable medium of claim 21, Unger further teaches: "annotating at least one of the first group, third group, or any portion of any document contained in the first group or the third group" at Col. 4 lines 50-57.

As per claim 34, Unger and Hill teach the computer readable medium of claim

21 discussed above. Unger further teaches: "wherein the initial group of documents is

from at least one of a database, an external source, or the Internet" at Col. 4 lines 1-2.

Claims 35-92 recite a method, system, computer program product, and a device

for performing similar method as in claims 21-34. Claims 35-92 are therefore rejected by

the same reasons discussed above.

Response to Arguments

3.   Applicant's arguments filed have been fully considered but they are not

persuasive. The examiner respectfully traverses applicant's arguments.

4.   Regarding claim 21, applicant argued that Unger and Hill as combined does not

teach or suggest "analyzing a third group of documents according to one or more

analytical functions to output a fourth group of documents, wherein the fourth group of

documents is a subset of the third group of document". On the contrary, Unger teaches

this limitation at Col. 6 lines 25-55 reproduced below:

> "The database system allows patents and/or technical documents to be
>
> electronically captured and analyzed at a convenient time. **This set of**
>
> **analyzed patents and/or technical documents** may be then used to
>
> identify trends and discontinuities in the overall pattern of research efforts
>
> represented by the set of patents or technical documents"
>
> ....

"The dashed line from Stage V to Stage I represents the fact that the data stored in the database, and all associated analyses of Stage II although VI, may be used to identify **patents and/or technical documents of particular interest for a particular application**. The patent numbers for this set of patents may then be used as unique identifiers to electronically links to full text resources of patents and displayed the full text and associated images of the set of patents"

Unger therefore clearly teaches the step of analyzing a set of "**patents and/or technical documents**" to output a sub set of "**patents and/or technical documents of particular interest for a particular application**".

Applicant further argued that Unger fails to teach "selectively initiating at least one iteration of a search and at least one iteration of analysis". On the contrary, the examiner relied on Hill for teaching of this limitation. Hill teaches a method for recursive document retrieval including the steps of selectively iterating at least one of the searching step and analyzing step, wherein each iteration of the searching step or the analyzing step is performed using as input the second group of documents, the fourth group of documents, or the output of the previous iteration" at Col. 3 line 1 to Col. 4 line 25 and Figs. 1-4. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Hill's iteration method with Unger's method as suggested by Hill at Col. 4 lines 10-20, in order to improve the relevancy of the search results. Hill's Fig. 2 reproduced below clearly show the iteration steps:
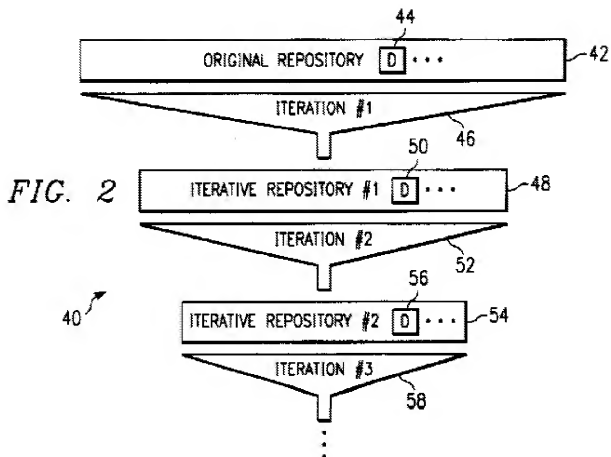
FIG. 2

Applicant further argued that Hill does not teach or suggest "**selectively** iterating at least one of the searching step", on the contrary, as seen in Fig. 2 above, Hill clearly teaches the step of selectively iterating at least one of the searching step".

The same rejection and arguments are also applied to claims 35-39. The examiner also notes that claims 49 recite the phrase "the processor is **capable of**" which does not limit the claim because any processor is capable of performing the cited functions, with proper configuration.

In view of applicant's amendment and arguments, the 101 rejection has been withdrawn.

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh B. Pham/
Primary Examiner
Art Unit 2166

August 10, 2009